

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Rodney M. Richards)
Theodore Jones)
Serial No.: 220,108)
Filed: June 24, 1988)
For: Method and Reagents for)
Amplifying and Detecting)
Nucleic Acid Sequences)
Group Art Unit: 180)
Examiner: Scheiner)

REPLY BRIEF
(37 CFR 1.193)

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Dear Sir:

This is a Reply to the Examiner's Answer in this case mailed on July 15, 1992.

The required petition for extension of time for filing this reply and fees therefor are dealt with in the accompanying REQUEST FOR ORAL HEARING.

CERTIFICATE OF FACSIMILE TRANSMISSION

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I. NEW POINTS OF ARGUMENT (37 CFR 1.193(b))

The Examiner has raised a new point of argument regarding the format of Applicants' claims. Specifically, the Examiner has now raised a new rejection on the basis that Applicants have not drafted their claims in a Jepson format. Importantly, the Examiner states for the first time during prosecution of the present case that the detection system of the present invention "... may in fact confer an unexpected advantage over the prior art." (Examiner's Answer, p. 6.) However, the Examiner appears to suggest that such an advantage is somehow negated, because Applicants "... persist in arguing and claiming that the amplification method as well as the detection method is unobvious over the prior art." (*Ibid.*)

While the Examiner is correct in suggesting that Applicants have not abandoned their arguments of patentability with respect to amplification method, such a posture should in no way negatively impact Applicants separate arguments of patentability with respect to the detection system, irrespective of whether Applicants ultimately prevail in their defense of the amplification claims. It is important to note, in this regard, that Applicants specifically placed the claims of the present invention into six groups for consideration on appeal: "(1) claims 1-5, directed to the amplification procedure alone; (2) claims 6-13, directed to the detection procedure alone; (3) claims 14-18 and 22-32, directed to the combined amplification/detection procedure; (4) claim 19, directed to amplification reagents alone; (5) claim 20, directed to detection reagents alone; and, (6) claims 21 and 33-39, directed to a kit containing both amplification and detection reagents." (Appeal Brief, p. 6.)¹ Applicants' arguments regarding advantages conferred by the detection system bear on claim groups 2, 3, 5 and 6, set forth above. Arguments raised in support of claim

¹Consequently, Applicants are at a loss to explain the Examiner's erroneous contention that, "[Applicants'] brief ... fails to present reasons in support [of Applicants' statement that the claims of the present invention do not stand or fall together]." (Examiner's Answer, p. 3.)

groups 1 and 4 herein cannot be said to negatively affect patentability of the other claim groups.

Moreover, it should be noted that the detection system of the present invention operates in concert with three or more pairs of amplification probes.² This is particularly important while other ligase-based amplification methods teach away from increasing the number of pairs of amplification probes.

Finally, the Examiner appears to raise as a rejection the fact that the present invention names joint inventors. Applicants have previously been reminded of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made, but have declined to do so because their are no such claims.

II. CONCLUSION

For the foregoing reasons, it is respectfully submitted that the Examiner's rejections in the present case be overturned.

Date: November 16, 1992

Julia E. Abers

Julia E. Abers

Reg. No. 31,222

Phone: (805) 499-5725, Ext. 3162

Please send correspondence pertaining to this application to:

Steven M. Odre/JEA

Amgen Inc.

1840 Dehavilland Drive

Thousand Oaks, CA 91320-1789

²Claim 5, for example, recites that limitation that at least three pairs of amplification probes be employed.